

Remarks

General

Applicant wishes to express his appreciation for the telephone interview granted 2006 August 17, and for the Examiner's concise summary mailed 2006 August 24. Applicant's transcript is attached hereto.

In light of the interview, Claim 12 has been amended to make more clear the meaning of its terms, and at the Examiner's suggestion, new dependent Claims 23-25 define more limited structure over amended Claim 12. Claim 12 is now in full condition for allowance and for appeal.

The Rejection of Claim 13

Independent claim 13 is hereby canceled without prejudice.

The Objection to Claims 14-22

Dependent claims 14-22 are canceled and rewritten in independent form as new claims 26-34 to overcome the objections of the Office Action and place them in condition for allowance.

The Rejection of Claim 12 under 35 U.S.C. §112, First Paragraph

The Final Office Action mailed 2006 June 6 states that the original disclosure does not support a single fold line at one end. Applicant notes that this single fold line is supported throughout the history of this application. It is clearly shown even in Figure 1 of the Provisional Patent Application filed 2002 December 2, and is cited as "fold line 11" in the subsequent formal application currently under examination. Reference to fold line 11 was absent from original, and succinct, Claim 1 because a single fold line is characteristic of the family of conventional wallets in use today, as claimed.

Claim 1 was rejected in the first Office Action mailed 2005 November 16 in light of Giard 5,671,481 which teaches a sweatband folded longitudinally once along its length (Giard, Figure 6) and then wrapped circularly around a wrist or ankle (Giard, Figures 1 and 3). Although Giard nowhere suggests that her wristband be folded a second time in any manner, or used in any pocket in any way, the Office Action held that "Giard teaches a wallet shaped to fit in a front trousers pocket having rounded tapering around one edge."

This rejection necessitated the further restriction of Claim 1, thus rewritten as new Claim 12, to include reference to fold line 11. Figure 6 of Giard shows her sweat band, folded once and finally, in

an outline shape bearing similarities to Applicant's open and unfolded wallet in Figure 2. For Giard's sweatband to anticipate Applicant's claim, it would necessarily be folded at least a second time, somewhere, in order that it have a substantially rounded tapering along only one edge. Giard provides no suggestion or reason for folding in any way beyond that shown in her Figure 6.

Claim 12 was thus written to more clearly differentiate between Giard's closed configuration (Figure 6) and Applicant's closed configuration (Figure 1) — distinctly different shapes. Applicant's wallet is conventionally and solely folded about one single fold line, whereas Giard's sweatband, due to its intrinsically flexible "towel fabric" construction, may be folded, twisted and crushed into an unlimited variety of visionary shapes. Giard teaches only that it be "folded along a (single) longitudinal fold line 40" (Column 3, Line 51) and then shaped as a cylinder "to form a closed loop . . . to fit the wearer's wrist or ankle" (Column 4, Lines 20-21).

Claim 12 was further restricted by incorporating reference to shorter edge 13 and longest edge 16 to explicitly clarify the meaning of "rounded tapering along one side" as originally used in rejected Claim 1. Giard Figure 6 clearly shows rounded tapering along two edges, 50 and 60 — not one. Even though manifest in Applicant's specification, the words "when folded for placement in a front trousers pocket" and "two edges adjacent said single fold line" were added in Claim 12 to explicitly define structure for interpretation against Giard Figure 6.

In the interview granted 2006 August 17, the matter of fold line 11 was extensively discussed. The final rejection on the basis of new matter is entirely inappropriate, as there simply is no new matter introduced and no question whatsoever that the invention as claimed was held at the time of the Application. Nevertheless, the examiner holds that when several layers of material are folded together, then there are "multiple fold lines at portion 11."

As used and intended by the applicant, a fold line is a line of location where, or about which, a fold occurs — analogous, for example, to the center of a circle. It is not a portion. It does not exist in any tangible sense, but is called upon as a necessary geometrical construct to define a geometrical relationship. When several layers of material are folded at or about a single fold line, a single fold comprising these several layers is formed, about this single common fold line, just as a series of concentric cylinders is necessarily formed around a single common center line or axis.

Applicant calls upon fold line 11 in describing numerous features of his invention, just as a cartographer would call upon the equator or the polar axis in describing numerous features of the earth.

The word "single" as used in Claim 12 takes its simplest meaning — single, or "one only," "one and no more," "individual," "alone," "solitary," "having only one part; not double, compound, multiple, etc."

Applicant's wallet is folded once about a single fold line, 11, to form a shape as shown in his Figure 1. Giard's sweatband is folded once about a single fold line, 40, to form the shape as shown in her Figure 6. Applicant has a longest edge 16 and a shorter edge 13, only the shorter edge being rounded, while Giard has two identical edges, 50 and 60, both of which are rounded.

Claim 12 has been amended in light of the interview to absolutely and explicitly clarify any question regarding the meaning of a single fold line.

Likewise, in the interview, there was considerable discussion on the word "edge."

As used and intended by the Applicant, the word "edge" is a "border" or "margin," "the line where an object or area begins or ends," "the part farthest from the middle." Claim 12 (and abandoned Claim 1) is a claim as to shape — in particular, the shape of a wallet. As such, an edge would not be a line drawn somewhere within the periphery or outline of the object being described. It would of necessity be an outer edge.

In the interview, the examiner made clear that he is construing a line shown in Giard's Figure 5, neither numbered in the drawings nor discussed in the specification, as an edge. In his words, "There are a plurality of edges, and there are obtuse angles on one of the pockets; that's another edge of the wallet . . . if you look at Figure 5 there is a slanted portion of the flap . . . right adjacent to number 90 . . . that's an edge."

If Applicant correctly understands the Examiner's words, the edge he is describing is the straight line seen indeed as an edge in Figure 7, where it is seen crossing behind the arrow pointing to pocket 100. Applicant holds that, when folded as in Figures 5 and 6 of Giard, this "edge" is not an edge defining the shape of her folded sweat band. It is more properly the edge of a feature, as for example edge 23 in applicant's Figure 2. Neither its position nor its existence nor its function act as an edge in defining the shape of Giard's singly-folded sweatband.

The Rejection of Claim 12 under 35 U.S.C. §112, Second Paragraph

The office action rejects Claim 12 as being indefinite in that the term "shorter edge is confusing, i.e. shorter than what?"

Applicant notes that the terms used to define features of his invention are at his choosing. Where there are several like features, it's both commonplace and permissible to add qualifying words to further differentiate and to more exactly define such features from one another. Applicant's reasoning in assigning the word "shorter" to edge 13 and "longest" to edge 16 is indeed discretionary, but when seen visually as a part of a generally rectangular object with a rounded corner, the edge 13 seems visually shorter than the edge 16, and hence the choice of the modifier "shorter." The location of these two edges is clear in the drawings, clear in the specification, and clear in the claims.

Furthermore, the wording "shorter edge" is grammatically correct in the English language, as in "she's my shorter child," when referring to one of two objects.

This rejection is unsupported and wholly inappropriate.

The Rejection of Claim 12 under 35 U.S.C. §102(b) as being anticipated by Wieland

The Office Action states, incorrectly, that Wieland 601,922 teaches a wallet "having a single fold line (between panels g in Fig. 3)" and a "shorter edge having substantially round tapering (at h)."

Clearly evident in Wieland's Figure 2 (and in his first claim), his wallet has two — not one single — fold lines. In Wieland's case, the first of these two fold lines (not numbered for reference) is at a transverse fold, seen in Figure 2 as an approximately horizontal crease extending left-to-right just a short ways below the lowest of the three lowercase "a" characters, and described at Column 1 Line 49.

The second fold line is at a longitudinal fold, formed after the first fold has been completed. The fold itself is seen as the vertical right edge of the drawing in Wieland's Figure 1, and as a more-or-less vertical central crease in Figure 2. From Wieland's Figure 3 may be seen three layers of material that are folded together in this one fold about Wieland's second fold line, further illuminating the 'fold versus fold line' discussion above.

Regarding the "substantially rounded tapering," Applicant notes that neither Wieland, nor any other, teaches substantially rounded tapering. Wieland, at Column 2 Lines 76-78, clearly teaches that only those sharp corners which are of single thickness and therefore "liable to injury" require rounding (Column 2 Lines 74-78). Applicant notes the grammatically significant distinction between the passive "liable to injury" and the active "liable to cause injury."

One contemporary example of such rounding as is envisaged and taught by Wieland would be the rounded corners of three-ring notebook paper. In drafting technical drawings for a machined part, for another such example, it's customary to add a general note instructing the machinist to "break all sharp edges" to render those edges less prone to injury from striking against other objects. Even Applicant, as shown consistently in each of his Figures 1 through 5, anticipates such a process, showing without discussion rounded corners at virtually every corner.

In Applicant's invention, only one corner is "substantially rounded," and that is the one corner which gives the invention its novel shape such that it fits a front trousers pocket.

The word "substantial" as used by Applicant in Claim 12, takes its customary meaning: "important," "essential," "ample," "full," "being specified to a large degree (as in a substantial victory)," "considerable," "large," "of considerable value." Here it means more than simply rounding off a corner to protect the corner from damage; it means, for example, half the entire width of the wallet, so that the wallet's shape fits a front trousers pocket.

The wallet Wieland teaches is moreover constructed with "minimum cost of manufacture" and is "adapted to receive on its surfaces advertisements or the like where it may be employed advantageously as an advertising medium" (Column 1, Lines 17-21). Wieland thus teaches against the expensive, durable and mark-resistant materials such as leather that are conventionally used in trousers wallets.

Wieland teaches the benefits, for his invention, of having open ends which permit "long documents to be projected" (Column 1, Lines 39-45). Applicant teaches a construction where the ends are instead bonded or stitched, such that documents are constrained in the wallet to protect them from damage they otherwise would incur in a front trousers pocket.

Because Applicant is the first to consider a wallet of such a shape, and for such a purpose, in spite of the long history of tapered front pockets and long-building awareness of the adverse effects resulting from conventional wallets used in rear trousers pockets, Applicant is entitled to a broad claim to this invention. It would be inappropriate to limit his invention to any more specific degree of rounding or tapering than that such rounding is "substantial" and as such is a defining feature of the wallet — not as the simple and customary measure to avoid damage as taught for Wieland's "stiff paper" (Column 1, Line 32) wallet. More than Wieland's fragile single-thickness corners would be damaged if a user were but once to use it in a front trousers pocket and to then assume a seated or crouched position. Nothing in Wieland would be advantageous in constructing Applicant's wallet.

Summary

In spite of the simplicity of Applicant's breakthrough, no other has recognized or appreciated the inherent advantages of implementing it in the prior art. Heretofore, the only suggestion has been to stop wearing a wallet in the rear trousers pocket, or to force a conventional wallet into a front trousers pocket, causing discomfort, awkward fitting, and early tearing of the pocket. Applicant's results are new, superior, unsuggested, and — from a health perspective — critical.

Applicant has solved an entirely different problem from the references in the prior art, as Applicant has clearly recited in his claims. Nevertheless, the Office Actions have consistently presented unconvincing and shifting arguments based on strained interpretations, misinterpretations and misunderstandings of the prior art.

Giard 5,671,481 has modified an absorbent towel-like sweatband to hold loose articles such as keys and pocket money that would normally find no place in exercise clothing, thus making it simple to carry such objects while for example jogging away from one's home. Giard recognizes that providing a notch to avoid localized pressure on an ankle or wristbone works to enhance freedom of movement during use. The Office Action interprets this sweatband to be a wallet and the notch to be equivalent to and anticipating Applicant's rounded tapering.

Wieland 601,922 proffers a minimally expensive paper folder for casually protecting papers and for bearing printed advertisements. The Office Action somehow misinterprets Wieland as providing a wallet folded and shaped as Applicant's.

Gomi 1,972,480 and Christiansen 4,332,338 disclose novel constructions for strapping a rectangular wallet about an arm or a leg. Sandos 4,209,048, Williams 4,570,688 and Jacks 5,341,972 propose other novel features in an otherwise conventional rectangularly-shaped wallet — for example holding a wrist watch, being able to float, or being capable of attachment to the wearer's body.

Nowhere is found the suggestion to modify or simplify these prior art inventions to provide a folding front trousers pocket wallet shaped for use in a trousers front pocket or to avert damage to one's spine. In fact all the references would need to be examined with hindsight and then further seriously strained to be interpreted as anticipating Applicant's invention.

Applicant responded properly and constructively to the first Office Action, and was met by a second Office Action alleging a new-matter rejection, citing three new references, and making this second Office Action final.

Applicant appropriately studied the second Office Action and, via facsimile, requested arranging a telephonic interview after final, to discuss and more clearly develop and clarify the specific issues for rejection and the interpretations that led to them. Each issue to be discussed was individually delineated. Failing a reply from the Examiner after two weeks, Applicant initiated an unscheduled telephone call to the Examiner, resulting in an impromptu interview that the Examiner graciously extended to over one-half hour. Points of discussion were taken up and discussed spontaneously, with the hope of leading to mutual understanding, thoroughly identifying issues, and resolving differences, thus to advance the prosecution of the application. Applicant notes that much discussion focused on understanding the concepts of "folding" and "edges" which arise in numerous grounds for rejection. The Examiner did offer to consider an amendment restricting the discussion of edges to "outer" edges and to reconsider Claim 12 if amended with several dependent claims.

Claim 12 has been so amended.

Applicant has invented a novel device with significant health benefits. While one can always argue obviousness with the invention in hand and the problem solved, Applicant's invention required the spark of intuition that is nowhere demonstrated in the prior art record. Though no doubt having a history spanning hundreds of centuries, beginning with simple mouth- or hand-carrying, the earliest rudimentary containers, pouches, drawstring bags, strapped satchels, purses, and more recently pocket books — only after the comparatively recent invention of clothing and of pockets — and finally wallets, no one has developed a wallet shaped to fit a front trousers pocket.

Applicant is simply the first to conceive and to reduce to practice a folding wallet shaped for use in a front trousers pocket, and is entitled to a broad claim to his breakthrough. The Office Actions bear this out by drawing on non-analogous references such as flexible, absorbent sweatbands and folded-paper constructs, none of which would be relevant or applicable to solving Applicant's problem.

While the prior art discloses many inventive wallets, pocket books, and purses, nowhere are any of them suited nor suggested for solving Applicant's problem-at-hand. In spite of generations of skilled artisans designing wallets, and of a growing awareness of the spinal and neurological hazards of sitting on a conventional wallet, not one has recognized or solved the problem as has the Applicant, which in itself attests to its unobviousness. Moreover, Applicant's growing commercial success attests to the need for such a solution and militates in favor of patentability for this never-before-conceived product.